The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT R. BUCKLEY, EMIL V. RAINERO, JAMES W. REID, and PAMELA B. SPITERI

Appeal No. 2006-2615
Application No. 10/042,987

ON BRIEF

MAILED
OCT 30 2006
U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before KRASS, BLANKENSHIP, and HOMERE, ***Administrative Patent Judges***.

HOMERE, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 7 through 16, all of which are pending in this application. Claims 1 through 6 have been canceled by Appellants.

We reverse.

INVENTION

Appellants' invention relates generally to a method for allowing a user at a client computer to view requested documents at a server computer. First, a client generates and sends to a server a request identifying a non-rasterized document, a section of the document, and a compression format suitable to the client computer. Upon receipt of the request, the server computer retrieves the identified section of the non-rasterized document. Next, the server rasterizes the identified section, and then compresses the rasterized section pursuant to the compression format identified by the client computer. Further, the server computer sends the compressed rasterized section to the client computer and the client decompresses the received compressed image before viewing the image on its display.

Claim 7 is representative of the claimed invention and is reproduced as follows:

> 7. A method for viewing, on a client-side device, documents requested from a server-side device the client-side device and server-side device having a communication link therebetween, comprising:

(a) generating a request from a client-side device to be sent to a server-side device, the request identifying a non-rasterized document, a section of the non-rasterized document to be sent to the client-side device, and a compression format corresponding to the client-side device;

(b) the server-side device retrieving, in response to receiving the request from the client-side device, the requested non-rasterized document and identifying the requested section of the requested non-rasterized document;

(c) the server-side device rasterizing the identified section of the requested non-rasterized document;

(d) the server-side device compressing the rasterized section of the requested non-rasterized document into a compressed image having the identified compression format corresponding to the client-side device;

(e) the server-side device communicating the compressed image to the client-side device;

(f) the client-side device decompressing the received compressed image; and

(g) the client-side device displaying the decompressed image.

REFERENCES

The Examiner relies on the following reference:

Dekel et al. (Dekel) 6,314,452 Nov. 6, 2001
(Filed on Aug. 31, 1999)

REJECTIONS AT ISSUE

A. Claims 7 through 10, 13 through 15 stand rejected under 35 U.S.C. § 102 as being anticipated by Dekel.

B. Claims 11 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dekel.

Rather than reiterate the arguments of Appellants and the Examiner, the opinion refers to respective details in the Briefs[1] and the Examiner's Answer.[2] Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the Briefs have not been taken into consideration. See 37 CFR 41.37(c)(1) (vii)(eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the Examiner's rejections, the arguments in support of the rejections and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have,likewise, reviewed and taken into consideration Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in the rebuttal set forth in the Examiner's Answer.

[1] Appellants filed an Appeal Brief on January 4, 2006. Appellants filed a Reply Brief on April 6, 2006. Appellants filed a supplemental Reply Brief on April 24, 2006.
[2] The Examiner mailed an Examiner's Answer on February 7, 2006. The Examiner mailed an office communication on July 3, 2006 stating that the Reply Briefs have been entered and considered.

After full consideration of the record before us, we do not agree with the Examiner that claims 7 through 10 and 13 through 15 are properly rejected under 35 U.S.C. § 102 as being anticipated by Dekel. We also do not agree with the Examiner that claims 11 and 16 are properly rejected under 35 U.S.C. § 103 as being unpatentable over Dekel. Accordingly, we reverse the Examiner's rejections of claims 7 through 16 for the reasons set forth **infra**.

I. Under 35 U.S.C. § 102(e), is the Rejection of claims 7 through 10, and 13 through 15 as Being Anticipated By Dekel Proper?

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to representative claim 7, Appellants argue in the Appeal and Reply Briefs that the Dekel reference does not disclose the limitation of rasterizing an identified section of a requested non-rasterized document before compressing said rasterized section into a compressed image. Particularly, at

page 6 of the Appeal Brief, Appellants state that "Dekel et al. fails to teach that the server-side device rasterizes the identified section of the requested non-rasterized document before compressing the (rasterized) section of the requested non-rasterized document into a compressed image having the identified compression format corresponding to the client side device, as set forth in independent claim 7."

To determine whether claim 7 is anticipated, we must first determine the scope of the claim. We note that representative claim 7 reads in part as follows:

> [T]he server-side device rasterizing the identified section of the requested non-rasterized document.

At page 5, lines 3 through 7, Appellants' specification states the following:

> The server retrieves and converts the requested documents, if they have not been previously converted, to a raster image that is then compressed according to attributes based on information received from the client device in the initial document request.

Thus, representative claim 7 does require rasterizing an identified section of a requested non-rasterized document before compressing said rasterized section into a compressed image.

Now, the question before us is what Dekel would have taught to one of ordinary skill in the art? To answer this question, we find the following facts:

At column 22, line 38 through column 23, line 6, Dekel states the following:

> With reference to FIG. 8, the operation of the server computer 120 (FIG. 1) will now be described. Initially, an uncompressed digital image is stored in, for example, storage 122 of the server computer 120. This uncompressed digital image may be a two-dimensional image, stored with a selected resolution and depth. For example, in the medical field, the uncompressed digital image may be contained in a DICOM file. In the graphic arts field, the uncompressed image may be, for example, in the Tiff standard format or a result of a RIP (Raster Image Processing) algorithm converting a postscript file to a raster image.
>
> Once the client computer 110 requests to view or print a certain image, the server 120 performs the preprocessing step 801. This step is a computation performed on data read from the original digital image. The results of the computation are stored in the server cache device 121. After this fast computation, a ready to serve message is sent from the server 120 to the client 110 containing basic information on the image.
>
> In step 802, the server 120 receives an encoded stream of requests for data blocks associated with a ROI that needs to be rendered at the client 110. The server 120 then decodes the request stream and extracts the request list.
>
> In step 803, the server 120 reads from cache 121 or encodes data block associated with low resolution portions of the ROI, using the cached result of the preprocessing stage 801.
>
> If the ROI is a high resolution portion of the image, the server 120, in step 804, reads from cache 121 or performs a "local" and efficient version of the preprocessing step 801. Specifically, a local portion of the uncompressed image, associated with the ROI, is read from

> the storage 122, processed and encoded. Data encoded in steps 803-804 is progressively sent to the client 110 in the order it was requested.

With the above discussion in mind, we find that with regard to representative claim 7, the Dekel reference teaches a "Pixels on Demand" method and system for allowing a user at a client computer to retrieve in real time a region of interest (ROI) of an image from a server without having to encode and decode the full image. Particularly, Dekel teaches that upon receipt of a request from a client computer (110) to view or print an image, the server (120) preprocesses the image and notifies the client that it is ready to serve the image. The client then submits a request for a ROI to the server, which in turn fetches from its cache (121) the portion of the image corresponding to the ROI. The server then performs an on-demand encoding of the ROI, and progressively forwards portions of the image to the client in response to progressive request orders received from the client. Dekel further teaches that uncompressed digital images stored in storage (122) can be in the Tiff standard format or a result of a RIP (Raster Image Processing) algorithm that converts a postscript file into a raster image. Additionally, Dekel teaches that the server stores pre-processing results in cache (121) from which data blocks associated with a low resolution of the ROI are fetched. In the event that the ROI is

associated with a high resolution of the image, the server reads from cache (121) or reads a local version of the ROI associated with the image in storage (122).

It is our view that one of ordinary skill in the art at the time of the present invention would have readily found that Dekel's teaching of storing uncompressed images in Tiff standard or raster image formats are examples of the different types of uncompressed images that can be stored in memory. The ordinarily skilled artisan would have duly recognized from Dekel's teaching that such uncompressed images, regardless of their formats, are not subject into any conversion before they are compressed and sent to the client. Thus, the ordinarily skilled artisan would be readily apprised of the fact that by teaching that the uncompressed image can be in raster image format, Dekel does not neccesarily indicate that the ROI requested by the client was initially in a non-rasterized format, and that it was converted into a rasterized format before compression. Consequently, we find error in the Examiner's stated position, which concludes that Dekel teaches the limitation of rasterizing an identified section of a requested non-rasterized document before compressing said rasterized section into a compressed image. It is therefore our view, after consideration of the record before us, that the evidence relied upon and the

level of skill in the particular art would not have suggested to the ordinarily skilled artisan the invention as set forth in claims 7 through 10 and 13 through 15. Accordingly, we will not sustain the Examiner's rejection of 7 through 10 and 13 through 15.

II. Under 35 U.S.C. § 103, is the Rejection of Claims 11 and 16 as being unpatentable over Dekel Proper?

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788. Thus, the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion.

However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. ***In re Kahn***, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing **In re Kotzab**, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). See also **In re Thrift**, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to claims 11 and 16, Appellants argue in the

Appeal and Reply Briefs that Dekel does not teach claimed invention. Particularly, Appellants assert that Dekel does not teach the limitation of rasterizing an identified section of a requested non-rasterized document before compressing said rasterized section into a compressed image. We have already addressed this argument in the discussion of claim 7 above, and we agree with Appellants. It is therefore our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to the ordinarily skilled artisan the invention as set forth in claims 11 and 16. Accordingly, we will not sustain the Examiner's rejection of claims 11 and 16.

CONCLUSION

In view of the foregoing discussion, we have not sustained the Examiner's decision rejecting claims 7 through 10, and 13 through 15 under 35 U.S.C. § 102. We have also not sustained the Examiner's decision rejecting claims 11 and 16 under 35 U.S.C. § 103. Therefore, we reverse.

REVERSED

ERROL A. KRASS)
Administrative Patent Judge)
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HOWARD B. BLANKENSHIP) BOARD OF PATENT
Administrative Patent Judge)
) APPEALS AND
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JEAN R. HOMERE) INTERFERENCES
Administrative Patent Judge)
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JH/gw

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BASCH & NICKERSON LLP
1777 PENFIELD ROAD
PENFIELD, NY 14526